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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,634

07/19/2005

Junya Takahashi

1823-0128PUS1

6943

2292 7590 05/23/2008  
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EXAMINER

ZHU, WEIPING

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

05/23/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/542,634	TAKAHASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	WEIPING ZHU	1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/19/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-9 are currently under examination, wherein claims 1-9 have been amended in applicant's amendment filed on March 6, 2008.

### ***Status of Previous Rejections***

2. The previous rejections of claims 1-9 as stated in the Office action dated November 6, 2007 have been maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 05-033866 as stated in the Office action dated November 6, 2007.

With respect to the amended features of claim 1, they do not change the scope of the claim, the reasons as stated in the Office action dated November 6, 2007 are further applied herein properly.

4. Claims 2-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP ('866) as applied to claim 1 above and in view of JP 2002-310299 as stated in the Office action dated November 6, 2007.

With respect to the amended features of claims 2-4 and 6-8, they do not change the scopes of the claims, the reasons as stated in the Office action dated November 6, 2007 are further applied herein properly.

5. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP ('866) in view of JP ('299) as applied to claims 2 and 6 above and further in view of JP 02-214796 A as stated in the Office action dated November 6, 2007.

With respect to the amended features of claims 5 and 9, they do not change the scopes of the claims, the reasons as stated in the Office action dated November 6, 2007 are further applied herein properly.

### ***Response to Arguments***

6. The applicant's arguments filed on March 6, 2008 have been fully considered but they are not persuasive.

First, the applicant argues that the Example 3 of JP ('866) corresponds to the Comparative Example 1 in the instant specification because austenitic stainless steel is subjected to salt nitriding therein; the steel of the instant invention have at least S1, S2 and S3 phases, while the Comparative Example 1, analogous to JP ('866), has no S phases at all; therefore, surface structures of JP ('866) and the instant invention are different. In response, the examiner notes that the rejection was based on the prior art's broad disclosure rather than preferred embodiments. See MPEP 2123. JP ('866) in view of JP ('299) and further in view of JP ('796 A) meet all the claim limitations. The application of the case law of *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) and/or MPEP 2112.01 [R-3] I is proper and maintained. Furthermore, the

applicant's argument that the Example 3 of JP ('866) corresponds to the Comparative Example 1 in the instant specification is not persuasive. It would have been obvious to one of ordinary skill in the art at the time the invention was made that even if the nitriding materials and methods are the same, the resultant properties could be significantly different depending on the nitriding parameters used in the process. JP ('866) does not disclose the parameters of the salt-bath soft nitriding in Example 3, which could be different from those used in the Comparative Example 1 in the instant specification.

Second, the applicant argues that the wear properties of the steel of the instant invention are far superior to the product of the Comparative Example 1. In response, see the response to applicant's 1<sup>st</sup> argument above. Furthermore, JP ('866) discloses that the wear is prevented by the nitriding process (paragraph [0027], machine translation).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

WZ

5/9/2008